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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/786,895 | 02/24/2004 | Eduard K. de Jong | SUN-P9178 | 6753 |
| 24209 | 7590 | 05/02/2006 | EXAMINER | |
| GUNNISON MCKAY & HODGSON, LLP 1900 GARDEN ROAD SUITE 220 MONTEREY, CA 93940 | | | LE, UYEN CHAU N | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2876 | |

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/786,895 | Applicant(s) DE JONG, EDUARD K. | |
| | Examiner Uyen-Chau N. Le | Art Unit 2876 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2006.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☒ Claim(s) 1-20 and 39-59 is/are allowed.
 6) ☒ Claim(s) 21-38 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>02/17/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Prelim. Amdt/Amendment

1. Receipt is acknowledged of the Amendment filed 02/03/2006.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 21-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Saltz (US 2005/0149926A1).

Re claims 21-38: Saltz discloses a method for selecting a desired application on a Java card 202, which serves as a smart card, wherein there are potentially two or more applications [A-G] installed on the smart card 202, each application having a stored application identifier (AID), the method comprising: specifying a desired application in terms of multiple parameters; retrieving multiple parameters from a stored AID for

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an application on the smart card 202; and comparing the specified multiple parameters with the retrieved multiple parameters to determine whether or not there is a match (paragraphs [0038-0055]); wherein the smart card 202 is separated into one or more firewalls, with each application installed on the smart card being contained within one of the firewalls, and wherein one of the parameters is indicative of the firewall in which the desired application is contained (paragraphs [047-0053]; wherein one of the parameters comprises an applet ID that identifies an application within a firewall (paragraphs [0053-0054]; wherein one of the parameters comprises a registered application provider identifier (RID) (paragraph [0055]); wherein the RID comprises a predetermined first portion of the AID, and one or more remaining parameters are contained within a predetermined second portion of the AID (paragraph [0055]); wherein the multiple parameters comprise an RID, a firewall identifier, and an applet identifier (paragraphs [0053-0055]); wherein the smart card 202 is brought into communication with a terminal (i.e., card acceptance device 224), and the terminal transmits a request to the smart card specifying a desired application in terms of the multiple parameters (paragraph [0039]); further comprising returning to the terminal in response to the request the AID of an application whose

retrieved parameters match the specified parameters (paragraphs [0039-0040]); wherein the request is received by an applet selector on the smart card, and the applet selectors calls a method on a control value 302, which serves as an AID interpreter associated with each application on the smart card to perform the retrieving (paragraphs 0045-0052]); wherein the AID interpreter 302 associated with each application performs the comparing and notifies the applet selector of whether or not there is a match for that application (paragraphs [0048-00850]); wherein the applet selector performs the comparing of the specified parameters with the retrieved parameters for each application (paragraphs [0048-00850]).

Allowable Subject Matter

2. Claims 1-20 and 39-59 are allowed.
3. The following is an examiner's statement of reasons for allowance:

The prior art of records to and all other cited references, taken alone or in combination, fails to teach or fairly suggest the specific structure or the method for selecting a desired application on a smart card comprising, among other things, receiving, on the smart card, a request including multiple parameters wherein the received multiple parameters specifying a

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desired application; retrieving an AID including the retrieved multiple parameters upon the comparing finding a match between the received multiple parameters and the retrieved multiple parameters as set forth in the claimed combinations.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

4. Applicant's arguments filed 02/03/2006 with respect to claims 21-38 have been fully considered but they are not persuasive.

5. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., ADPU commands are at least one set of multiple parameters for identifying a desired application on the smart card, and a communications interface for exchanging messages with the smart card) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

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See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 571-272-2397. The examiner can normally be reached on maxi-flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Uyen-Chau N. Le
Primary Examiner
Art Unit 2876

May 1, 2006